

REMARKS

Claims 1-4, 6-14, 17-20, 22, 25-27 and 34-52 are pending in this application. Claims 15-16 have been withdrawn from consideration due to the finality of the Restriction Requirement. For purposes of expedition, claims 5, 21, 23-24 and 28-33 have been canceled without prejudice or disclaimer. Claims 1, 6-7, 9, 14, 17-18, 20, 25, 34-36, and 50-52 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

As a preliminary matter, the Examiner acknowledges receipt of IDS filed on January 16, 2004, but has not considered a Japanese patent document, JP 10136314 contained therein because its English translation or translated abstract was not provided. In response thereto, the translated abstract of JP10136314 is enclosed for purposes of completeness and for the Examiner's consideration. Accordingly, entry of the Japanese patent document as a matter of record is respectfully requested.

Claims 1-14 and 17-52 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In regard to independent claims 1, 5, 6, 7, 9, 17, 20, 21, 22, 25, 28, 34, 50, 51, 52, the Examiner asserts that the "combined limitations within each said claim does not appear to be directed to a useful, concrete and tangible result. In particular, the combined limitations within each said claim do not appear to be transforming data from one form to another, therefore said claims are directed to non-statutory subject matter." As previously discussed, claims 5, 21, 23-24 have been canceled without prejudice or disclaimer. As for remaining claims, the Examiner's assertion is addressed herein below.

First of all, base claims 17, 20, 22, 25 and 50-52 are not directed to non-statutory subject matter under 35 U.S.C. §101 as incorrectly alleged by the Examiner. Rather, these base claims 17, 20, 22, 25 and 50-52 are directed to statutory methods to reproduce data in an interactive mode, including AV data using a markup document. Nevertheless, these base claims have been amended to clearly define that data is recorded on a data storage medium and is reproduced using a reproduction apparatus in an interactive mode, and such data includes a markup document and AV data that is linked and embedded in the markup document. In view of these changes, Applicants respectfully request that the rejection be withdrawn.

Similarly base claims 28 and 34 are not directed to non-statutory subject matter under 35 U.S.C. §101 as incorrectly alleged by the Examiner. Rather, these base claims 28 and 34 are directed to statutory devices and systems to reproduce data in an interactive mode, including AV data using a markup document. Nevertheless, in the interest of expedition, these base claims have been amended to clearly define that data is recorded on a data storage medium and is reproduced using a reproduction apparatus in an interactive mode, and such data includes a markup document and AV data that is linked and embedded in the markup document. In view of these changes, Applicants respectfully request that the rejection be withdrawn.

Lastly, Beauregard claims 1, 6, 7 and 9 have been amended to define operation in its intended environment, i.e., a reproduction apparatus. Again, in view of these changes, Applicants respectfully request that the rejection be withdrawn.

Claims 28-30, 32-33 have been rejected under 35 U.S.C. §102(e) as being anticipated by Lampkin et al., U.S. Patent Application Publication No. 2002-0088011 A1. In support of the rejection of base claim 28, the Examiner asserts that Lamkin '011 discloses,

"a DVD (a storage medium), AV data, including HTML documents in directories to reproduce said AV data in an interactive mode (a DVD video content and HTML content with extra information regarding said video encoded on said DVD, playable via computer connected to the Internet) (Lampkin Abstract, paragraph [0035], [0039], [0066], [0068]).

Lampkin teaches embedding AV data within an HTML documents (Lampkin paragraph [0017]), and a display device (Lampkin Figure 1 item 138)."

However, the Examiner's assertion is believed to be incorrect. There is **no** disclosure in Lamkin '011 of any reproduction of audio/visual (AV) data and markup documents in an interactive mode in which AV data corresponding to the markup document is embedded in the markup document for presentation, and any interaction between the markup document and the user in the manner defined in Applicants' base claim 28. However, for purposes of expedition, base claim 28 and its dependent claims 29-33 have been canceled without prejudice or disclaimer in order to render the rejection moot.

Separately, claims 1-14, 17-18, 20-27, 31, 34-49, and 51-52 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lampkin et al., U.S. Patent Application Publication No. 2002-0088011 A1, in view of Berstis et al., U.S. Patent No. 6,510,458 for reasons stated on pages 4-16 of the Office Action (Paper No. 20060401). Basically, the

Examiner admits that Lampkin '011, as a primary reference, does **not** disclose or provide display of information according to a "set parental level". Nevertheless, the Examiner further cites column 12, lines 5-10, lines 13-18; column 13, lines 15-20, 25-46, 54-59; column 18, lines 44-48; FIGs. 6-9 of Berstis '458, as a secondary reference, for allegedly disclosing this feature.

However, as previously discussed, claims 1, 6-7, 9, 14, 17-18, 20, 25, 28, 32-36, and 50-52 have been amended to render much of this rejection moot. To the extent that the rejection may still be applicable, Applicants note that there is **no** distinction made between the markup document and AV data, nor any user ability to interact with a reproducing apparatus (i.e., DVD player), as shown in FIG. 1, as defined in claims 1, 6-7, 9, 14, 17-18, 20, 25, 28, 32-36, and 50-52. More importantly, there is **no** disclosure or suggestion from either Lamkin '011 or Berstis '458, whether taken individually or in combination, of Applicants' claimed data recorded on a data storage medium to be reproduced, via a reproduction apparatus in an interactive mode, in which interactive content is controlled, via parental setting information, in the manner defined generally by Applicants' claims 1, 6-7, 9, 14, 17-18, 20, 25, 28, 32-36, and 50-52.

As a primary reference, Lamkin '011 discloses a system for providing enhanced DVD content for play at a client device 208, as shown in FIG. 2, across multiple playback platforms, ranging from computers (such as Windows and Macintosh) to Internet-connected set-top devices. ROM/HTML content 202 and DVD-video content 206 are recorded on the DVD disc 204 which is inserted into a client device 208 that contains Browser/Presentation software 210 (such as Netscape Navigator or some other forms of engine commonly available on personal computers). A typical client device 208 is shown in FIG. 1, including a CPU 110, RAM 114, ROM 116, I/O adapter 118 for connecting to a disk storage unit 120 (i.e., DVD playback device), interface adapter 122, display device 136 for connecting to a display unit 138, and communication adapter 134 for connecting to the Internet.

The Browser/Presentation software 210 is then activated, upon instruction from a user, to search the Internet to find supplemental information related to the DVD content 202, 206 and incorporate the supplemental information into the DVD content 202, 206 to create an Internet enhanced DVD experience 214. According to Lamkin '011, an InterActual Technologies Cross Platform ("ITX") specification is utilized to allow multiple playback platforms to seamlessly combine the Internet and/or other DVD-ROM capabilities with DVD-video to create a richer, more interactive, and personalized entertainment experience for customers.

The purpose of Lamkin's invention, as described on paragraph [0018], is to address the

need for a system to easily and efficiently update content provided on a DVD-disk, via a network such as the Internet. Previously, the content is fixed once the DVD-disk is manufactured, and the content that the user can access from the DVD-disk is limited to the content provided when the disk is manufactured. In order to update the content, a new disk must be created and delivered to the user which can be expensive and inconvenient. On paragraph [0039], Lamkin '001 describes that "a preferred embodiment ... utilizes Hypertext Markup Language (HTML) to implement documents on the Internet together with a general-purpose secure communication protocol for a transport medium." As a result, HTML update must be accessed on-line, as shown in FIG. 3, and the content of the DVD-disk can be updated, as shown in FIG. 2A.

Again, there is no distinction made between the markup document and AV data, nor any user ability to interact with a reproducing apparatus (i.e., DVD player), as shown in FIG. 1.

As a secondary reference, Berstis '458 does not remedy the noted deficiencies of Lamkin '011 in order to arrive at Applicants' claims 1, 6-7, 9, 14, 17-18, 20, 25, 28, 32-36, and 50-52. This is because Berstis '458 only discloses a Web-based filter system in a Web browser (such as, Microsoft Internet Explorer application) installed at a computer system in which a user can set preference parameters to filter web page contents, such as XXX-rated materials available on the Internet. However, such a Web-based filter system is well-known, and only suggests that the Web browser (such as, Microsoft Internet Explorer application) be equipped to allow users to filter un-desirable materials, via the Internet. If Berstis '458 is to be incorporated into the system of Lamkin '011 for providing enhanced DVD content for play at a client device 208, as shown in FIG. 2, across multiple playback platforms, ranging from computers (such as Windows and Macintosh) to Internet-connected set-top devices, the proposed incorporation still does **not** arrive at Applicants' claims 1, 6-7, 9, 14, 17-18, 20, 25, 28, 32-36, and 50-52. This is because Applicants' parental rating information is incorporated as part of the markup documents, and is not based any Web-based systems as alleged by the Examiner.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must

be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Lamkin '011 and Berstis '458 fail to disclose and suggest key features of Applicants' claims 1, 6-7, 9, 14, 17-18, 20, 25, 28, 32-36, and 50-52.

1. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 19 and 50 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lampkin et al., U.S. Patent Application Publication No. 2002-00880011 A1, in view of Berstis et al., U.S. Patent No. 6,510,458, in further view of Kenner et al., U.S. Patent No. 6,421,726 for reasons stated on pages 16-17 of the Office Action. As previously discussed, base claim 50, as amended, defines a method to reproduce data recorded on a data storage medium using a reproduction apparatus in an interactive mode, comprising:

- "selecting the interactive mode;
- reading data recorded on the data storage medium in the interactive mode, including mark-up documents and audio/visual (AV) data that are linked and embedded in the mark-up documents;
- identifying a parental level set by a user;
- identifying the parental level written in a mark-up document designated as a start-up document;
- comparing the parental level recorded in the mark-up document with the parental level set by the user;
- reproducing the AV data in the interactive mode using the mark-up document with a warning message indicating that the interactive content corresponding to the AV data cannot be displayed when the parental level written in the start-up document is less than the parental level set by the user; and
- reproducing the AV data in the interactive mode using the mark-up document comprising the interactive content to the AV data when the parental level written in the start-up document is higher than the parental level set by the user."

None of the cited prior art references, including Lampkin '011, Berstis '458, and Kenner '726 discloses, whether individually or in combination, any of these specific steps. As secondary references, Bertsis '458 simply discloses a Web-based filter system in a Web browser (such as an Internet Explorer application) in which a user can set preference parameters to filter web page contents. In contrast, Kenner '726 simply disclose a completely different data delivery scheme to enable content providers to dynamically locate delivery sites at optimum network locations and allow users to select optimum sites from which to receive data. No where in these references is there any specific step used to allow data recorded on a data storage medium to be reproduced, via a reproduction apparatus in an interactive mode, in which interactive content is controlled, via parental setting information, in the manner defined by Applicants' base claim 50. In view of these significant differences and the foregoing explanations, Applicants trust that the rejection of claims 19 and 50 be withdrawn.

Lastly, dependent claim 31 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Lampkin et al., U.S. Patent Application Publication No. 2002-00880011 A1, in view of Berstis et al., U.S. Patent No. 6,510,458 for reasons stated on pages 17-18 of the Office Action. Since this rejection is predicated upon the correctness of the rejection of its base claim 28, Applicants respectfully traverse the rejection primarily for the same reasons discussed.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext. 232.

INTERVIEW:

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. attorney at the local Washington, D.C. telephone number (202) 216-9505 ext. 232 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this

Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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